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APR 15 2004

OFFICE OF PETITIONS

In re Application of
King Sheng Wang
Application No. 09/812,853
Filed: March 21, 2001
Title: TILTING SUPPORT DEVICE
HAVING DAMPING DEVICE

DECISION ON PETITION UNDER
37 C.F.R. §1.137(a)

This is a decision on the petition under 37 CFR §1.137(a)¹, filed March 23, 2004, to revive the above-identified application.

The above-identified application became abandoned for failure to submit the issue fee in a timely manner in reply to the Notice of Allowance and Issue Fee Due (notice), mailed July 2, 2003, which set a shortened statutory period for reply of three (3) months. No extensions of time are permitted for transmitting issue fees². Accordingly, the above-identified application became abandoned on October 3, 2003. A Notice of Abandonment was mailed November 11, 2003.

With the instant petition, petitioner has included the petition fee and a statement from the inventor where it is asserted that the notice of July 2, 2003 was not received.

The instant petition lacks item (3) above.

Regarding the first required item, Petitioner has not submitted the required reply. A copy of the

¹ A grantable petition pursuant to 37 CFR 1.137(a) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in § 1.17(l);
- (3) A showing to the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unavoidable;
- (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

² See MPEP §710.02(e).

notice of July 2, 2003 has been included with this decision, so that the issue fee may be submitted with the renewed petition.

Regarding the petition fee, Petitioner has submitted payment in the amount of \$665.00. The fee associated with the filing of a petition under 37 C.F.R. §1.137(a) is \$55.00. As such, Petitioner has overpaid in the amount of \$610. If the petitioner wishes to have the \$610.00 overpayment refunded, he should submit a request for refund to the Office of Finance³. A copy of this decision should accompany any such request.

As to item (3), the showing of record is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable within the meaning of 37 CFR 1.137(a).

The Commissioner is responsible for determining the standard for unavoidable delay and for applying that standard.

“In the specialized field of patent law, . . . the Commissioner of Patent and Trademarks is primarily responsible for the application and enforcement of the various narrow and technical statutory and regulatory provisions. The Commissioner’s interpretation of those provisions is entitled to considerable deference.”⁴

“[T]he Commissioner’s discretion cannot remain wholly uncontrolled, if the facts **clearly** demonstrate that the applicant’s delay in prosecuting the application was unavoidable, and that the Commissioner’s adverse determination lacked **any** basis in reason or common sense.”⁵

“The court’s review of a Commissioner’s decision is ‘limited, however, to a determination of whether the agency finding was arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with the law.’”⁶

3 The Refund Branch processes all customer requests for refunds. It generally takes four to six weeks for a request to be processed and a check generated. All requests for refund should be sent to: Mail Stop 16, Director of the US Patent and Trademark Office, PO Box 1450, Alexandria, VA 22313-1450. Office hours are Monday - Friday from 8:30 AM to 5:00 PM. To check the status of a request that has been filed please contact the Refund Branch directly at 703-305-4229.

4 Rydeen v. Quigg, 748 F.Supp. 900, 904, 16 U.S.P.Q.2d (BNA) 1876 (D.D.C. 1990), *aff’d* without opinion (Rule 36), 937 F.2d 623 (Fed. Cir.1991) (citing Morganroth v. Quigg, 885 F.2d 843, 848, 12 U.S.P.Q.2d (BNA) 1125 (Fed. Cir. 1989); Ethicon, Inc. v. Quigg 849 F.2d 1422, 7 U.S.P.Q.2d (BNA) 1152 (Fed. Cir. 1988) (“an agency’s interpretation of a statute it administers is entitled to deference”); *see also* Chevron U.S.A. Inc. v. Natural Resources Defence Council, Inc., 467 U.S. 837, 844, 81 L. Ed. 694, 104 S. Ct. 2778 (1984) (“if the statute is silent or ambiguous with respect to the specific issue, the question for the court is whether the agency’s answer is based on a permissible construction of the statute.”))

5 Commissariat A L’Energie Atomique et al. v. Watson, 274 F.2d 594, 597, 124 U.S.P.Q. (BNA) 126 (D.C. Cir. 1960) (emphasis added).

6 Haines v. Quigg, 673 F. Supp. 314, 316, 5 U.S.P.Q.2d (BNA) 1130 (N.D. Ind. 1987) (citing Camp v. Pitts, 411 U.S. 138, 93 S. Ct.1241, 1244 (1973) (citing 5 U.S.C. 706 (2)(A)); Beerly v. Dept. of Treasury, 768 F.2d 942, 945 (7th Cir. 1985); Smith v. Mossinghoff, 217 U.S. App. D.C. 27, 671 F.2d 533, 538 (D.C. Cir.1982)).

“The scope of review under the arbitrary and capricious standard is narrow and a court is not to substitute its judgment for that of the agency.”⁷

The standard

“[T]he question of whether an applicant’s delay in prosecuting an application was unavoidable must be decided on a case-by-case basis, taking all of the facts and circumstances into account.”⁸

The general question asked by the Office is: “Did petitioner act as a reasonable and prudent person in relation to his most important business?”⁹

Nonawareness of a PTO rule will not constitute unavoidable delay¹⁰

The burden of showing the cause of the delay is on the person seeking to revive the application¹¹.

A delay caused by an applicant’s lack of knowledge or improper application of the patent statute, rules of practice, or the MPEP is not rendered “unavoidable” due to either the applicant’s reliance upon oral advice from USPTO employees or the USPTO’s failure to advise the applicant to take corrective action¹².

The portion of the MPEP relevant to the abandonment of this application

MPEP 711.03(c) states, in part:

PETITION TO WITHDRAW HOLDING OF ABANDONMENT BASED ON FAILURE TO RECEIVE OFFICE ACTION

In *Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant’s representative did not receive the original Notice of Allowance. Under the reasoning of *Delgar*, an allegation that an Office action was

⁷ *Ray v. Lehman*, 55 F.3d 606, 608, 34 U.S.P.Q.2d (BNA) 1786 (Fed. Cir. 1995) (citing *Motor Vehicles Mfrs. Ass’n v. State Farm Mut. Auto. Ins. Co.*, 463 U.S. 29, 43, 77 L.Ed.2d 443, 103 S. Ct. 2856 (1983)).

⁸ *Id.*

⁹ See *In re Mattulah*, 38 App. D.C. 497 (D.C. Cir. 1912).

¹⁰ See *Smith v. Mossinghoff*, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (citing *Potter v. Dann*, 201 U.S.P.Q. (BNA) 574 (D.D.C. 1978) for the proposition that counsel’s nonawareness of PTO rules does not constitute “unavoidable” delay). Although court decisions have only addressed the issue of lack of knowledge of an attorney, there is no reason to expect a different result due to lack of knowledge on the part of a pro se (one who prosecutes on his own) applicant. It would be inequitable for a court to determine that a client who spends his hard earned money on an attorney who happens not to know a specific rule should be held to a higher standard than a pro se applicant who makes (or is forced to make) the decision to file the application without the assistance of counsel.

¹¹ *Id.*

¹² See *In re Sivertz*, 227 USPQ 255, 256 (Comm’r Pat. 1985).

never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of Delgar is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee (35 U.S.C. 151) or for failure to prosecute (35 U.S.C. 133).

To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. For example, if a three month period for reply was set in the nonreceived Office action, a copy of the docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. See Notice entitled "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 O.G. 53 (November 16, 1993).

The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions).

Evidence of nonreceipt of an Office communication or action (e.g., Notice of Abandonment or an advisory action) other than that action to which reply was required to avoid abandonment would not warrant withdrawal of the holding of abandonment. Abandonment takes place by operation of law for failure to reply to an Office action or timely pay the issue fee, not by operation of the mailing of a Notice of Abandonment. See *Lorenz v. Finkl*, 333 F.2d 885, 889-90, 142 USPQ 26, 29-30 (CCPA 1964); *Krahn v. Commissioner*, 15 USPQ2d 1823, 1824 (E.D. Va 1990); *In re Application of Fischer*, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1988).

Two additional procedures are available for reviving an application that has become abandoned due to a failure to reply to an Office Action: (1) a petition under 37 CFR 1.137(a) based upon unavoidable delay; and (2) a petition under 37 CFR 1.137(b) based on unintentional delay.

Application of the standard to the current facts and circumstances

In the instant petition, petitioner maintains that the circumstances that led to the abandonment of the application meet the aforementioned unavoidable standard and, therefore; petitioner qualifies for relief under 37 CFR 1.137(a). In support thereof, petitioner contends that this mailing was never received.

The filing of a petition under the "unavoidable" standard carries with it a high standard. As such, it is insufficient to merely state that the mailing was not received. Petitioner must not only state that the Office communication was not received, but also that he searched the place where he normally would keep such communications and could not find it. Petitioner must explain his system for keeping track of patent matters – where he keeps the correspondence¹³; where he writes down due dates¹⁴; how he knows replies are due, etc. In essence, Petitioner must explain how he reminds himself of response due dates and show that the Notice was not entered into that

¹³ Does the Petitioner have a file/some means of organization where he keeps correspondence pertaining to this application?

¹⁴ This need not be a log. This may be in the form of a calendar or date book.

system. The Office would like to see documentary evidence and records as may exist which would substantiate that Petitioner exercised due diligence with respect to his most important business.

For these reasons, petitioner has failed to show the correspondence at issue was not received.

On the facts presented, this situation fails to constitute unavoidable delay. These facts might constitute an unintentional delay in prosecution, but it certainly does not rise to the level of unavoidable.

Therefore, it is determined that the petitioner cannot establish that the entire delay in filing the required reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable which is required in order for relief to be granted under 37 CFR 1.137(a).

Consequently, the petition is **DISMISSED**.

Any response must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extension of time under 37 CFR 1.136(a) are permitted. The submission should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(a)". This is not a final agency action within the meaning of 5 U.S.C 704.

The renewed petition may be submitted by mail¹⁵, hand-delivery¹⁶, or facsimile¹⁷.

The reply should display "Please deliver to Paul Shanowski, c/o Office of Petitions" in a prominent manner. The Petitioner may wish to consider telephoning the undersigned at the number provided below to confirm that the documents were delivered to the undersigned. Please note that the delivery process within the PTO can take as much as three weeks.

The application file will be retained in the Office of Petitions for two (2) months.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (703) 305-0011.



Paul Shanowski
Senior Attorney
Office of Petitions
United States Patent and Trademark Office

Encl. Copy of notice mailed July 2, 2003

¹⁵ Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

¹⁶ Customer Window, Mail Stop Petition, Crystal Plaza Two, Lobby, Room 1B03, Arlington, Virginia 22202.

¹⁷ (703) 872-9306 - please note this is a central facsimile number, and as such, there will be a delay in the delivery of the facsimile to the undersigned.